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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/343,517	06/30/1999	ROBERT BURNETT	A7489	8018

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INTELLECTUAL PROPERTY DEPARTMENT  
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[REDACTED] EXAMINER

FERRIS, DERRICK W

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

2663

DATE MAILED: 09/24/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/343,517

**Applicant(s)**

BURNETT, ROBERT

**Examiner**

Derrick W. Ferris

**Art Unit**

2663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 20 August 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1,3-6 and 24-26 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3-6 and 24-26 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 16 October 2000 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____                                     |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/20/03 has been entered.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 3-6, and 24-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,461,624 to *Mazzola* in view of "TUBA: Replacing IP with CLNP" by *Katz et al.* ("Katz").

As to **claims 1, 5-6, and 24-26**, *Mazzola* discloses IS gateway devices in figure 2b where the protocols for the gateway devices are disclosed in figure 4b.

*Mazzola* is silent or deficient to routing IP over SONET (i.e., a "synchronous optical network"). Instead *Mazzola* clearly discloses routing CLNP over SONET using a DCC channel as is known in the art (see figure 4a). Applicant general invention relates to the following noted in applicant's summary:

*"The present invention obviates the above deficiencies of the known techniques by tunneling management data and other information to and from remotely located IP NEs via the SONET DCC by placing IP over the Connection Less Network Protocol (CLNP) that is present in OSI" [Applicant's specification pages 2-3].*

Examiner notes that it would have been obvious to someone skilled in the art prior to applicant's invention to translate an IP packet to a second communications protocol (e.g., CLNP) (i.e., to place IP over CLNP). Examiner first notes that *Mazzola* provides a reasonable expectation of success by disclosing for illustrative purposes, the block diagrams (Fig. 4a and 4b) are specific for a SONET application; however, the method disclosed in a patent may be used in connection with other protocols as well for the physical layer, data layer, and network layer (e.g., examiner notes another protocol at the network layer to be IP) [column 5, lines 7-25]. *Katz* also helps cure the deficiency by disclosing that IP maps (i.e., "translates") to CLNP [see section "Mapping IP functionality to CLNP" starting on page 44 of *Katz*]. In particular, *Katz* teaches "most functions of IP map directly to matching functions in CLNP" [page 44, middle right-hand column]. Thus *Katz* provides a relationship and thus provides a motivation by not only mapping IP and CLNP but also providing a mechanism for routing the two protocols [page 38] using an approach called TCP and UDP with Bigger Addresses (TUBA). Examiner notes *Katz*'s motivation for mapping IP and CLNP (see figure 10 of *Katz* on page 45) is due to problems with Internet growth and IP addressing. Examiner notes with the mapping, the rest of the limitations fall into place given the combined teachings of both references. Specifically, shown in Figure 8 of *Katz* is interarea routing for CLNP using IS-IS at the core and ES-IS at the edge. Furthermore, *Mazzola* also discloses routing for SONET/CLNP using ES-IS [column 1, lines 20-25]. Thus in summary,

*Mazzola* discloses CLNP running over SONET-OSI (as is known in the art) and *Katz et al.* discloses IP running over “CLNP” thus IP can “run” over CLNP which runs over SONET-OSI. It would have been furthermore obvious to implement this knowledge over a set of routers in a network forming both a local gateway and a remote gateway as is well known in the art given a reasonable but broad interpretation of the claimed subject matter, and based on the examples provided by both references (e.g., shown in figure 2a of *Mazzola* and figure 6 of *Katz et al.*). Again, the motivation being that the Internet consists of more than one router as is well known in the art which forms local and remote gateways respectively (which could be directly or not directly attached) for a local and remote host.

*Mazzola* discloses a method for distributing routing between network elements for CLNP. *Katz et al.* provides mapping IP to CLNP. As both references revolve around CLNP there exists a motivation for combining the subject matter as a whole for both references for the purpose of making this rejection.

As to **claims 3, 4**, specifically, data is routed using CLNP, and a tunnel is created using a reasonable but broad interpretation of the claimed subject matter. In addition, both *Mazzola* and *Katz et al.* disclose NSAP addressing. Examiner notes that EI-IS and IS-IS contain routing table(s). Furthermore, *Katz et al.* discloses mapping IP to NSAP addressing [pages 40-41]. As IP can be replaced by CLNP it is possible for the two to coexist.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (703) 305-4225. The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (703) 308-5340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.

Derrick W. Ferris  
Examiner  
Art Unit 2663

DWF

  
CHI PHAM  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600 4/2/03